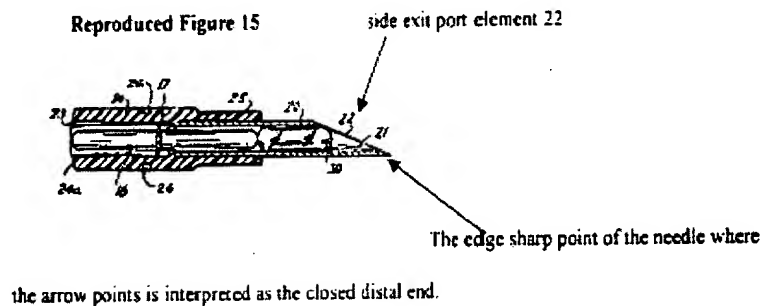


### REMARKS

Reconsideration of the rejections set forth in the Final Office Action mailed January 12, 2005, is respectfully requested. Claim 46 and 58 have been amended. Support for these amendments can be found in the specification at, e.g., Figs. 4-8. Therefore, no new matter was added with these amendments. Claims 46-51, 54-62, and 65-67 remain pending in this application.

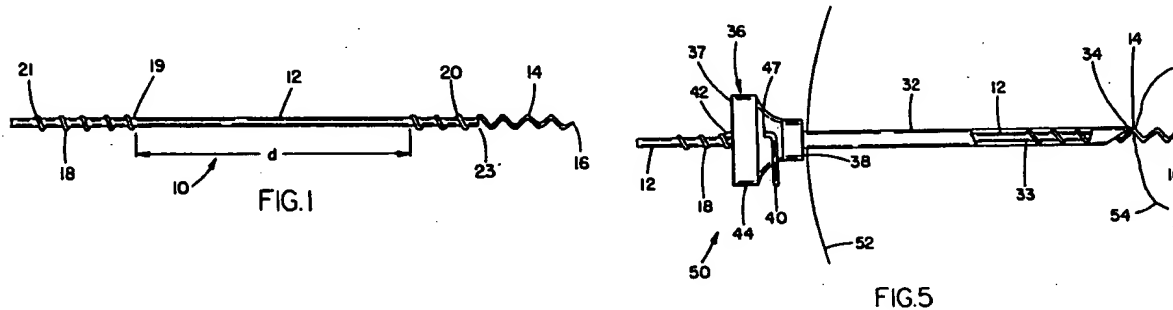
#### Art Rejections

Claim 46 was rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Campbell et al. (USP Re. 34,936). Applicants respectfully assert that Campbell et al. does not teach or suggest all of the limitations of the currently amended claim. In particular, Campbell et al. does not disclose *"a side exit port defining a plane, the plane being parallel to the longitudinal axis of the tube."* As apparent from Fig. 15, reproduced from the Office Action below, the side exit port element 22 (as assigned by the examiner in the Office Action) is not parallel to the longitudinal axis of the tube.



Claims 46-51, 54-62, and 65-67 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Edwards et al. (USP 5,470,308), in view of Rank et al. (USP 5,234,426) and Hirch et al. (USP 5,395,319). Applicants respectfully assert that the cited references are not properly combinable. As pointed out in our previous response, Edwards et al. concerns devices and methods

for taking biopsy samples and for tissue destruction. There is no motivation in Edwards et al. to insert a marker element in the device. Additionally, there is no motivation to combine the device of Edwards et al., which includes a cannula with a side port, with the marking device of Rank. The marking device of Rank consists of a marker having a shaft constructed of stainless steel with a helically wound wire secured to or wrapped around its distal end. (See figures below and Col. 4, lines 35-39)



The marker is deployed by rotating the marker, thereby causing the helical wire to exit the distal end of the cannula and advance into the lesion. Therefore, the marking device of Rank would not be operable for deployment through a side exit port because the marker is too big to pass sideways through the side port.

Furthermore, even if this combination was proper, there is no motivation to combine these references with the teaching of a shaft for pushing the marker, as seen in Hirch. As explained above, the marker of Rank is *rotated* into the lesion. A shaft would not be applicable to *push* this type of marker because it would not result in deployment of this marker. Additionally, with respect to claims 48, 50, and 60, this combination would not result in deployment of the marker such that “no part of the marker element extends outside the body,” as required by the claims.

Claims 46, 47, 48, 49, 50, and 60 are therefore patentably distinct from the cited art. Claims 51 and 54-58 are dependent on claim 50, and are therefore patentably distinct from the cited art for the same reasons. Claims 61-62 and 65-67 are dependent on claim 60, and are therefore patentably distinct from the cited art for the same reasons.

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,  
O'MELVENY & MYERS LLP

Dated: April 12, 2005

By: Diane K. Wong  
Diane K. Wong  
Reg. No. 54,550  
Attorneys for Applicants

JCK/DKW/cp

O'Melveny & Myers LLP  
114 Pacifica, Suite 100  
Irvine, CA 92618-3315  
(949) 737-2900